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| 10/698,810 | 10/30/2003 | Sumit Roy | 200313235-1 | 2478 |

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| EXAMINER | |
|---|---|
| TRAN, PHILIP B | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/698,810 | ROY ET AL. | |
| | Examiner | Art Unit | |
| | Philip B. Tran | 2155 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *08 March 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-41* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2/5/04 & 3/8/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Objections*

1. Claim 37 is objected to because of the following informalities: In claim 37 line 1, the phrase "the computer-usable medium of claim 32 ..." should be "the computer-usable medium of claim 33..."

Appropriate correction is required.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 9 and 33 of the instant application (10/698,810) are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over some claims of copending Application No. 10/698,812 (or US 2005/0015765 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because modifications are obvious.

Regarding claim 1, claim 1 of U.S. copending Application No. 10/698,812 contains every element of claim 1 of the instant application and as such anticipate claim 1 of the instant application.

Regarding claim 9, claim 5 of U.S. copending Application No. 10/698,812 contains every element of claim 9 of the instant application and as such anticipate claim 9 of the instant application.

Regarding claim 33, claim 35 of U.S. copending Application No. 10/698,812 contains every element of claim 33 of the instant application and as such anticipate claim 33 of the instant application.

4. Claims 13, 29 and 38 of the instant application (10/698,810) are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over some claims of copending Application No. 10/698,811 (or US 2004/0236847 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because modifications are obvious.

Regarding claim 13, claim 14 of U.S. copending Application No. 10/698,811 contains every element of claim 13 of the instant application and as such anticipate claim 13 of the instant application.

Regarding claim 29, claim 25 of U.S. copending Application No. 10/698,811 contains every element of claim 29 of the instant application and as such anticipate claim 29 of the instant application.

Regarding claim 38, claim 36 of U.S. copending Application No. 10/698,811 contains every element of claim 38 of the instant application and as such anticipate claim 38 of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 U.S.C. § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-7 and 33-36 are rejected under 35 U.S.C. § 102(e) as being anticipated by Menditto et al (Hereafter, Menditto), U.S. Pat. No. 6,981,029.

Regarding claim 1, Menditto teaches a method of servicing content for delivery to a client device (= processing the request from a client and providing the requested content to the client) [see Abstract], said method comprising:

identifying a type of service to be performed on an item of content, wherein said item of content is identified during a session involving said client device (= identifying an information source to satisfy the request in response to additional content of the request) [see Abstract and Col. 1, Lines 45-67 and Col. 11, Line 18 to Col. 12, Line 17 and Col. 12, Lines 33-56];

selecting a provider from a plurality of providers capable of performing said service (= locating the best server and network connection for delivering data to the client terminal) [see Col. 3, Lines 1-61]; and

providing information for transferring said session to said provider, wherein said provider performs said service on said item of content (= providing information such as

quality of service value along with modified packet before the packet is forwarding to the identified server) [see Col. 13, Line 7 to Col. 14, Line 58].

Regarding claims 2-4, Menditto further teaches the method of claim 1 wherein said selecting comprises maintaining a record of providers to which sessions have been transferred, and selecting said provider according to said record, estimating an amount of time said session is expected to remain with said provider, wherein said record is updated once said amount of time has passed, and receiving an indication from said provider that said service is completed, wherein said record is updated in response to said indication [see Col. 1, Lines 45-67 and Col. 13, Line 7 to Col. 14, Line 58].

Regarding claim 5, Menditto further teaches the method of claim 1 wherein said provider is selected according to a round-robin scheme (= selecting based on contract policies) [see Col. 2, Line 53 to Col. 3, Line 10].

Regarding claim 6, Menditto further teaches the method of claim 1 wherein said provider is selected at random (= selecting randomly based on locality) [see Col. 3, Lines 51-61].

Regarding claim 7, Menditto further teaches the method of claim 1 wherein said transferring comprises sending information for locating said provider to said client

device, wherein said client device and said provider transparently establish communication [see Col. 3, Line 38 to Col. 4, Line 56].

Claim 33 is rejected under the same rationale set forth above to claim 1.

Claims 34-36 are rejected under the same rationale set forth above to claims 2-4.

7. Claims 13-32 are rejected under 35 U.S.C. § 102(e) as being anticipated by Janik, U.S. Pat. Application Pub. No. US 2002/0013852 A1.

Regarding claim 13, Janik teaches a system for providing content to a client device (= providing Internet and digital content to a variety of thin client devices) [see Abstract], said system comprising:

a service manager for receiving a request for an item of content from a portal, wherein said portal received said request from said client device, said service manager also for selecting a provider from a plurality of providers, each provider capable of performing a service on said item of content, wherein a session with said client device is redirected from said portal to said provider such that said session continues via said provider, and wherein said provider performs said service on said item of content and forwards service result content to said client device (= a web portal for accessing and selecting content is used in conjunction with graphic user interfaces on a PC for setting up and controlling the content channels wherein Internet and digital content is delivering from the server to clients) [see Abstract and Figs. 1-2 & 23 and Paragraphs 0074-0109].

Regarding claims 14-16, Janik further teaches the system of claim 13 wherein said service manager maintains a history of providers engaged in session wherein said provider is selected according to said history, wherein said service manager identifies an amount of time said session is estimated to remain with said provider wherein said history is updated in response to said amount of time transpiring, and wherein said manager receives an indication that said service has been performed wherein said history is updated in response [see Figs. 1-2 and Paragraphs 0027-0040 & 0074-0109].

Regarding claim 17, Janik further teaches the system of claim 13 wherein said provider is selected according to a round-robin scheme (= selecting content types stored at different servers based on content preference selection) [see Paragraphs 0082-0104].

Regarding claim 18, Janik further teaches the system of claim 13 wherein said provider is selected at randomly [see Abstract and Paragraphs 0025-0027].

Regarding claim 19, Janik further teaches the system of claim 13 wherein said service manager sends information identifying said provider to said client device via said portal [see Abstract and Paragraphs 0082-0085].

Regarding claim 20, Janik further teaches the system of claim 13 wherein said service manager sends information identifying said provider directly to said client device, bypassing said portal [see Paragraphs 0191-0192].

Regarding claim 21, Janik further teaches the system of claim 13 wherein a source of said item of content is identified according to information provided in said request from said client device [see Abstract and Paragraphs 0082-0085].

Regarding claim 22, Janik further teaches the system of claim 13 wherein a source of said item of content is identified by one of said portal, said service manager and said provider [see Abstract and Figs. 1-2].

Regarding claim 23, Janik further teaches the system of claim 13 wherein said item of content is streamed from a content source to said provider [see Figs. 1-2 & 23 and Paragraphs 0102-0109].

Regarding claim 24, Janik further teaches the system of claim 13 wherein said type of service is identified according to information provided in said request received from said client device [see Paragraphs 0027-0040].

Regarding claim 25, Janik further teaches the system of claim 13 wherein said type of service is identified by one of said portal and said service manager [see Paragraphs 0074-0080].

Regarding claim 26, Janik further teaches the system of claim 13 wherein said service is continuously available from said provider [see Abstract and Figs. 1-2].

Regarding claim 27, Janik further teaches the system of claim 13 wherein said service is started up and executed in response to said client device establishing communication with said provider [see Paragraphs 0082-0085].

Regarding claim 28, Janik further teaches the system of claim 13 wherein said service manager directs said provider to start up said service upon selection of said provider [see Paragraphs 0102-0109].

Claim 29 is rejected under the same rationale set forth above to claim 13.

Claims 30-32 are rejected under the same rationale set forth above to claims 14-16.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 8-12 and 37-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Menditto et al (Hereafter, Menditto), U.S. Pat. No. 6,981,029 in view of Janik, U.S. Pat. Application Pub. No. US 2002/0013852 A1.

Regarding claim 8, Menditto does teach identifying a source of said item of content [see Menditto, Abstract and Col. 1, Lines 45-67 and Col. 3, Lines 1-61 and Col. 11, Line 18 to Col. 12, Line 17 and Col. 12, Lines 33-56] and Menditto also suggests that content such as JPEG images are provided to the client from the server [see Menditto, Col. 13, Lines 10-40]. However, Menditto does not explicitly teach wherein data for said item of content are streamed from said source to said provider and wherein service result data are streamed from said provider to said client device.

However, Janik, in the same field of delivering Internet and digital content from the providers to clients endeavor, discloses streaming content and data on the Internet such as streamed audio files from the server to the clients [see Janik, Abstract and Fig. 1 and Paragraphs 0074-0104]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teaching of Janik into the teaching of Menditto in order to provide an efficient way of automatically delivering of content of varying types, including rich content, and other services to the clients for a low total cost while insuring a high quality experience for the user in terms of audio and video quality and simple interaction [see Janik, Paragraphs 0025-0027].

Regarding claim 9, Mendtitto teaches a method of servicing content for streaming to a client device (= processing the request from a client and providing the requested content to the client) [see Abstract], said method comprising:

identifying a type of service to be performed on an item of content, wherein said item of content is identified during a session involving said client device (= identifying an information source to satisfy the request in response to additional content of the request) [see Abstract and Col. 1, Lines 45-67 and Col. 11, Line 18 to Col. 12, Line 17 and Col. 12, Lines 33-56];

selecting a provider from a plurality of providers capable of performing said service (= locating the best server and network connection for delivering data to the client terminal) [see Col. 3, Lines 1-61]; and

providing information for transferring said session to said provider, wherein said provider performs said service on said item of content (= providing information such as quality of service value along with modified packet before the packet is forwarding to the identified server) [see Col. 13, Line 7 to Col. 14, Line 58].

Menditto also suggests that content such as JPEG images are provided to the client from the server [see Menditto, Col. 13, Lines 10-40]. However, Menditto does not explicitly teach wherein data for said item of content are streamed from a content source to said provider and wherein service result data are streamed from said provider to said client device.

However, Janik, in the same field of delivering Internet and digital content from the providers to clients endeavor, discloses streaming content and data on the Internet such as streamed audio files from the server to the clients [see Janik, Abstract and Fig. 1 and Paragraphs 0074-0104]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teaching of Janik into the teaching of Menditto in order to provide an efficient way of automatically delivering of content of varying types, including rich content, and other services to the clients for a low total cost while insuring a high quality experience for the user in terms of audio and video quality and simple interaction [see Janik, Paragraphs 0025-0027].

Regarding claim 10, Menditto further teaches the method of claim 9 wherein said selecting comprises maintaining a record of providers to which sessions have been

transferred, and selecting said provider according to said record [see Col. 1, Lines 45-67 and Col. 13, Line 7 to Col. 14, Line 58].

Regarding claim 11, Menditto further teaches the method of claim 9 wherein said provider is selected according to a round-robin scheme (= selecting based on contract policies) [see Col. 2, Line 53 to Col. 3, Line 10].

Regarding claim 12, Menditto further teaches the method of claim 9 wherein said provider is selected at random (= selecting randomly based on locality) [see Col. 3, Lines 51-61].

Regarding claim 37, Menditto does teach identifying a source of said item of content [see Menditto, Abstract and Col. 1, Lines 45-67 and Col. 3, Lines 1-61 and Col. 11, Line 18 to Col. 12, Line 17 and Col. 12, Lines 33-56] and Menditto also suggests that content such as JPEG images are provided to the client from the server [see Menditto, Col. 13, Lines 10-40]. However, Menditto does not explicitly teach the computer-usable medium of claim 32 (should be claim 33) wherein said computer-readable program code embodied therein causes said computer system to perform said method further comprising wherein data for said item of content are streamed from a content source to said provider and wherein service result data are streamed from said provider to said client device.

However, Janik, in the same field of delivering Internet and digital content from the providers to clients endeavor, discloses streaming content and data on the Internet such as streamed audio files from the server to the clients [see Janik, Abstract and Fig. 1 and Paragraphs 0074-0104]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teaching of Janik into the teaching of Menditto in order to provide an efficient way of automatically delivering of content of varying types, including rich content, and other services to the clients for a low total cost while insuring a high quality experience for the user in terms of audio and video quality and simple interaction [see Janik, Paragraphs 0025-0027].

Claim 38 is rejected under the same rationale set forth above to claim 9.

Regarding claims 39-41, Menditto further teaches the computer-usable medium of claim 38 wherein said computer-readable program code embodied therein causes said computer system to perform said method further comprising maintaining a record of providers to which sessions have been transferred and selecting said provider according to said record, estimating an amount of time said session is expected to remain with said provider, wherein said record is updated once said amount of time has passed, and receiving an indication from said provider that said service is completed, wherein said record is updated in response to said indication [see Col. 1, Lines 45-67 and Col. 13, Line 7 to Col. 14, Line 58].

***Other References Cited***

10. The following references cited by the examiner but not relied upon are considered pertinent to applicant's disclosure.

A) Deng et al, U.S. Pat. Application Pub. No. US 2001/0039581 A1.

B) Swildens et al, U.S. Pat. Application Pub. No. US 2003/0065763 A1.

C) Turicchi, Jr. et al, U.S. Pat. Application Pub. No. US 2003/0005078 A1.

D) McKenna et al, U.S. Pat. No. 6,954,641.

E) Schilit et al, U.S. Pat. No. 6,674,453.

F) Montenegro et al, U.S. Pat. No. 5,694,537.

G) Wu, U.S. Pat. No. 7,171,206.

11. A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION. FAILURE TO RESPOND WITHIN THE PERIOD FOR RESPONSE WILL CAUSE THE APPLICATION TO BECOME ABANDONED (35 U.S.C. § 133). EXTENSIONS OF TIME MAY BE OBTAINED UNDER THE PROVISIONS OF 37 CAR 1.136(A).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (571) 272-3991. The Group fax phone number is (571) 273-8300. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar, can be reached on (571) 272-4006.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Philip Tran

Philip B. Tran
Primary Examiner
Art Unit 2155
April 19, 2007